



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/526,815

09/19/2005

Gerard J Barry

05-182

5799

20306

7590

03/19/2008

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER

TINKLER, MURIEL S

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

03/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,815	Applicant(s) BARRY, GERARD J	
	Examiner MURIEL TINKLER	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application has been reviewed. Claims 1-29 are pending. The rejection(s) are as follows.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-9 and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5-9 and 12-14 use the term, "according to any preceding claim" in line 1. This language should be changed to point to a specific claim or can be changed to use the term "any one of" instead.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-11 and 14, 22, 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Prasad (EP 1058217), hereafter referred to as Prasad.
5. Regarding claims 1, 15 and 25-29, Prasad discloses: (see claim 4, figs. 1 and 3; Par. 0025-0087) a method, performed by a computer system (fulfillment center 20)

having a network of terminals (ATMs), of transferring funds from a first payment cardholder (Sibling card 22) at a first merchant (ATM 26) to a second payment cardholder at a second merchant (ATM 28), said method comprising the steps of:

- a. receiving an indication from said first cardholder (Sibling card 22) at said first merchant that a transfer of funds is required to said second cardholder (Sibling card 24);
 - b. generating a first payment card transaction at a networked terminal (ATM) between said first merchant (ATM 26) and said first cardholder (Sibling card 22), wherein said first payment card transaction is a first immediate (real time) transfer, debiting said funds from said first cardholder (Sibling card 22) and crediting said funds to said first merchant (ATM 26);
 - c. generating a second payment card transaction at a networked terminal (ATM 28) between said second merchant and said second cardholder (Sibling card 24), wherein said second payment card transaction is a second immediate transfer, debiting said funds from said second merchant and crediting said funds to said second cardholder; and
 - d. communicating said first and second payment card transactions to a host (fulfilment center 20) across said network.
6. Regarding claims 2 – 4, 16-18 and 22, see Prasad, claim 1; paragraphs [0043, 0064].
7. Regarding claim 5, see Prasad, fig. 4 and description.

8. Regarding claims 6 and 19, see Prasad, paragraph [0064] currency exchange module 46.
9. Regarding claims 7 and 20, see Prasad, claim 1.
10. Regarding claims 8 and 21, see Prasad, paragraph [0080].
11. Regarding claims 9-11, see Prasad, paragraph [0085].
12. Regarding claim 14 see Prasad, paragraph [0031].

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 12, 13, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prasad as applied to claims 1 and 22 above, and further in view of Meyer et al. (US 2002/0128967), hereafter referred to as Meyer.
15. Regarding claims 12, 13, 23 and 24, Prasad discloses the information in claims 1 and 22. Prasad does not specifically disclose the act of identifying a suitable first/second merchant from details of the first/second cardholder. Meyer discloses the act of person-to-person money transfers using a unique barcode, an example of this is discussed in paragraphs 27-29. Therefore, it would have been obvious to use the concepts of person-to-person money transfers as taught by Meyer in Prasad because it combines well known techniques transferring funds via (electronic mail).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/526,815
Art Unit: 3691

Page 6

/M. T./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691